

Ser. No. 09/831,583

Response to Office Action of 10 July 2003
Atty Docket 116171-2

- 5 -

REMARKS**Claim status**

Claims 1-20 were pending at the time of the Office Action. Of these, claims 1, 3-5, 8, 9, 11-13 and 19 are rejected as lacking novelty; claims 1-3, 17 and 19 are rejected as being obvious; and claims 6, 7, 14-16, 18 and 20 are objected to as being dependent upon a rejected basic claim, but are otherwise allowable.

Priority

The applicants note that the Examiner has acknowledged the receipt of the priority documents.

Information Disclosure Statement

The applicants note that the Examiner has considered the Information Disclosure Statement filed on 21 June 2001.

Drawings

The applicants note that the Examiner has approved the drawings filed with the case.

Section 102 rejections

Claims 1, 3 and 19 relate to a battery sheath and are all rejected as being anticipated by either a published PCT application to Ohmura (WO 95/11527) or US Patent 5,993,994 to Ohmura ("Ohmura '994"). Claims 4, 5, 8, 9, and 11-13 are directed to a method for manufacturing strip stock and are similarly rejected. As the two Ohmura documents are in related, the Examiner has used Ohmura '994 as the cited reference. Applicants do not object to this, but applicant traverse the rejection. Applicants will deal first with the device claims and then with the process claims.

Claims 1, 3, 19

The Examiner's basis for rejection is that claim 1, as presented, does not distinguish between the electroplated metals in the coating and the "electrically conductive particles" that "are embedded in dispersed form in the electroplated coating." Since the metals are electrically conductive, they would constitute such disperse electrically conductive particles, according to the Examiner's logic.

While the Examiner has provided no real support for this latter point from Ohmura '994 and while the applicants believe that the Examiner's position is contrary to fact, as electroplating does not result in "disperse particles," claim 1 is amended to require that the particles comprise

Ser. N . 09/831,583

- 6 -

Response to Office Action of 10 July 2003
Atty Docket 116171-2

at least one material not selected from the group of metals. This is believed to distinguish Ohmura '994, and claim 1 is thus considered to now be allowable. If claim 1 is allowable, then claims 3 and 19 are also allowable.

Claims 4, 5, 8, 9, 11-13

The Examiner's basis for rejection is that claim 4, as presented, does not distinguish between the electroplated metals in the coating and the "electrically conductive particles" that "are embedded in dispersed form in the electroplated coating." Since the metals are electrically conductive, they would constitute such disperse electrically conductive particles, according to the Examiner's logic.

While the Examiner has provided no real support for this latter point from Ohmura '994 and while the applicants believe that the Examiner's position is contrary to fact, as electroplating does not result in "disperse particles," claim 4 is amended to require that the particles comprise at least one material not selected from the group of metals. This is believed to distinguish Ohmura '994, and claim 4 is thus considered to now be allowable. If claim 4 is allowable, then claims 5, 8, 9 and 11-13 are also allowable.

Section 103 rejections

Claims 1-3, 17 and 19 relate to a battery sheath and are all rejected as being obvious over a published Japanese application (10-012,199) to Okayama ("Okayama '199"). Applicants traverse this rejection.

The Examiner has admitted in the rejection that Okayama '199, standing by itself, does not teach the invention of any of these claims, because Okayama '199 only teaches forming a graphite film on a plated surface and does not teach the embedding of the graphite into the surface of the nickel-tin alloy. The Examiner contends, without any support, that it would have been obvious at the time of the invention for a person of ordinary skill to embed the conductive particles instead of just coating them on.

This unsupported position of the Examiner cannot withstand proper scrutiny. First, if the Examiner considers himself to possess the ordinary skill in this art, he is invited to put his declaration into the record. Second, if the embedding of the conductive particles would have been obvious, then it should have been obvious in Ohmura '994, or at least one of the other cited

Ser. No. 09/831,583

- 7 -

Response to Office Action of 10 July 2003
Atty Docket 116171-2

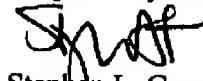
inventions teaching a electroplated nickel-tin coating. Simply put, Okayama '199 does not even indicate a knowledge of how to apply the graphite layer reliably until after the step of forming battery can by drawing the unplated metal (See paragraph [0011] of Okayama '199).

For at least these reasons, applicants assert that the Examiner has not made out a prima facie case of obviousness, so claims 1-3, 17 and 19 should be considered allowable.

Allowable subject matter

The applicants note that the Examiner has indicated that claims 6, 7, 10, 14-16, 18 and 20 would be allowable if in independent form. Applicants respectfully decline to put them into independent form at this time, as the amendments to claims 1 and 4 are believed to put the independent claims into allowable condition.

Respectfully submitted,



Stephen L. Grant
Reg. No. 33,390
Hahn Loeser + Parks LLP
1225 W. Market St.
Akron, OH 44313
330-864-5550
Fax 330-864-7986
Email: sgrant@hahnlaw.com
Customer No. 021324